

REMARKS

I. Status of the Claims

Claims 1, 4-9, and 11-32 are pending. Without prejudice or disclaimer, claim 4 has been amended herein, with support for the amendment found in the claims as originally filed. Accordingly, no new matter is added herein.

II. Rejection Under 35 U.S.C. § 103(a): Combination of Sturla et al. and Ashton et al.

The Examiner maintains the rejection of claims 1-28 and 30-32 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Application No. 2001/0051135 A1 to Sturla et al. ("Sturla") in view of U.S. Patent No. 6,350,433 B1 to Ashton et al. ("Ashton") for the reasons set forth at pages 2-6 of the Office Action. Specifically, the Examiner asserts that Sturla teaches an "aerosol device comprising a polyurethane and/or polyurea multiblock polymer in cosmetically acceptable medium" and a mixture of propellants which may include dimethyl ether and fluoro or non-fluoro hydrocarbons. Office Action at 3-4. The Examiner admits that Sturla does not teach the presently claimed combination of dimethyl ether and at least one C₃-C₅ hydrocarbon as propellants, and relies on Ashton to remedy this deficiency. *Id.* at 5.

The Federal Circuit has stressed that the teaching, suggestion, or motivation ("TSM") test retains an important role in obviousness analyses. *Takeda Chem. Indus., Ltd. v. AplhaPharm Pty., Ltd.*, 83 USPQ2d 1169, 1174 (Fed. Cir. 2007). The Court states that "[a]s long as the [TSM] test is not applied as a 'rigid and mandatory' formula, that test can provide 'helpful insight' to an obviousness inquiry. *Id.* (quoting *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1731 (2007).) Moreover, the Federal Circuit

stated that the Supreme Court in *KSR* “acknowledged the importance of identifying ‘a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does’ in an obviousness determination.” *Id.* Furthermore, the Federal Circuit subsequently held that proper support for a Section 103 rejection in the chemical arts requires the prior art to supply a reason or motivation to make the claimed compositions. *Aventis Pharma. Deutschland GmbH v. Lupin Ltd.*, 84 USPQ2d 1197, 1204 (Fed. Cir. 2007) (emphasis added) (citing *Takeda*, 83 USPQ2d at 1174).

With respect to the rejection over Sturla in view of Ashton, Applicants reassert that no such reason is given in the prior art why one skilled in the art would have been motivated to combine specific elements found in the prior art to render the present invention obvious, a requisite determination for obviousness rejections. Rather, the Examiner asserts in the present Office Action that it would have been obvious to combine Sturla and Ashton because Sturla “teaches that a mixture of propellants may be used for delivering a polyurethane composition” and Ashton “teaches a composition that comprises carboxylated polyurethanes for hair fixing.” Office Action at 5. Applicants disagree.

Sturla teaches that in certain embodiments, propellant gases such as “dimethyl ether, fluoro or non-fluoro hydrocarbons . . . or a mixture of these propellant gases, can be used as propellant gas.” *Id.* at paragraph [0066]. This passage makes clear that a broad disclosure of possible gases, alone or in any combination, can be used, in certain embodiments of Sturla. However, this teaching in no way signifies any advantage that a specific binary combination of gases may have; rather Sturla simply provides general

guidance. Sturla is wholly silent to any specific effect any particular propellant gas, or combination thereof, would have on the polyurethane. Accordingly, it cannot be said that Sturla provides any direction to one of ordinary skill in the art that one particular propellant or combination over another.

The Office's reliance on Sturla's general approach, however, cannot amount to a motivation for combination with Ashton. Instead, this rationale is akin to an obvious to try argument. Under *KSR*, and the revised M.P.E.P., an "obvious to try" rationale can only be supported when there is a "finite number of identified, predictable potential solutions to the recognized need or problem." M.P.E.P. § 2143(E). One of ordinary skill in the art would know that personal care products vary widely in terms of formulation of ingredients depending on the desired use, texture, appearance, etc., and that not all ingredients will be compatible nor provide the same desired outcome. The possible ingredients in hair compositions generally, cannot be considered "finite" the way the term was used in *KSR* to describe the location of a sensor on a pedal. See, e.g., *KSR Int'l Co. v. Teleflex, Inc.*, at 1734. The Examiner has offered no rational reason why, from the broad disclosure in Sturla, one of ordinary skill would have been drawn to the particular selection of propellant gases within the scope of the present claims.

In an attempt to provide motivation to combine the two references, the Examiner proffers "if one wanted to impart a similar single phase hair spray composition to the composition of Sturla et al. one would have been motivated to use the propellant mixture taught by Ashton et al.." *Id.* at 6. Ashton, however, lacks any direction whatsoever as to which particular propellant system would lead to which specific effect. Thus, the Examiner has not shown motivation between the two references to make

such a selection, other than by the Examiner applying impermissible hindsight reconstruction. Nothing, other than Applicants' disclosure, teaches or suggests the specific combination of a polyurethane with the binary propellant system comprising dimethyl ether and n-butane, of the claimed invention. Accordingly, for at least the reasons set forth above, Applicants submit that the rejection under 35 U.S.C. § 103 is improper and respectfully request its reversal.

Moreover, when a patent application claims a combination of prior art elements that work together in an unpredictable manner, the invention is non-obvious. See *KSR*, 127 S.Ct. 1727, 1740 (2007). To advance prosecution and further demonstrate that not any propellant can be combined with a polyurethane to yield a predictable result, Applicants submit the Declaration of François LE BOURHIS under 37 C.F.R. § 1.132 ("Declaration").

Based on the results presented in the Declaration, the sound level values for the present invention in comparison with the prior art are lower, i.e., the present invention allows for a more gentle spray to be generated. As demonstrated by the Declaration, use of the polyurethane in combination with dimethyl ether alone results in higher sound level values in comparison with the inventive compositions, which contained polyurethane in combination with the specifically recited binary propellant system. From these results, it becomes clear that not all propellants produce the same low level of sound and thus allow the same gentle spray to be generated. By examining the teachings of Sturla and Ashton, one cannot predict the combination of components that would result in a formulation that will allow a more gentle spray to be generated, as evidenced by the results in the Declaration. This unpredictability in the art substantiates

the absence of a reasonable expectation of success and supports the position that the teachings in the combined references merely provide a general approach, which is insufficient to establish a *prima facie* case of obviousness.

For at least the foregoing reasons and in view of the Declaration, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness and respectfully requests the withdrawal of the rejection.

III. Rejection Under 35 U.S.C. § 103(a): Combination of Sturla et al. and Ashton et al. and Carballada et al.

The Examiner maintains the rejection of claim 29 under 35 U.S.C. § 103(a) over Sturla and Ashton in view of U.S. Patent No. 6,703,008 to Carballada et al. (“Carballada”) for the reasons set forth at pages 6-8 of the Office Action. The Examiner admits that Sturla and Ashton do not teach “panthenol as [an] additional vitamin.” *Id.* at 7. Thus, the Examiner looks to Carballada to cure the deficiencies of Sturla and Ashton.

The Examiner contends that “[o]ne would have been motivated to add panthenol because it would provide the hair spray of Sturla et al. with a conditioning agent that would give a better hair feel .” *Id.* at 7. Absent the improper hindsight reconstruction of Applicants’ disclosure, there would have been no reasonable expectation of success in making the specific modification proposed by the Examiner. Because Sturla generally recites vitamins at page 4, paragraph [0067], Sturla provides no guidance to one of ordinary skill in the art to specifically include panthenol, over any of the other vitamins, into a hairspray composition to give hair a better feel. As previously stated in the Response submitted March 26, 2008, the exemplified composition disclosed in Sturla does not include any vitamin. See page 4, paragraph [0071].

Moreover, for the reasons set forth in the previous section, Sturla and Ashton fail to suggest the claimed polyurethane in combination with the specifically recited binary propellant system and Carballada fails to make up for this deficiency. Accordingly, Applicants traverse the rejection of claim 29 under § 103, and request that the rejection be withdrawn.

IV. Conclusion

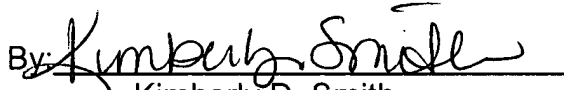
In view of the foregoing amendments, remarks, and Declaration, Applicants assert that the claimed invention is not rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 9, 2009

By: 
Kimberly D. Smith
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Attachment: Declaration under § 1.132 of François LE BOURHIS